

REMARKS

Reconsideration of this application is respectfully requested. Claims 1 and 20 have been amended to include the limitations recited in claims 23-25, and to change the transitional phrase “consisting essentially of” to “comprising.” Support for this amendment can be found throughout the specification at, e.g., page 2, line 22, to page 3, line 12, and page 11 (Table 1). Accordingly, no new matter has been added. Claims 23-25 have been canceled without prejudice or disclaimer.

Upon entry of this Amendment, claims 1, 2, 4 and 7-22 are pending. Claims 12-19 have been withdrawn from consideration. Accordingly, claims 1, 2, 4, 7-11, and 20-22 are currently at issue.

Obviousness Rejections

Claims 1, 2, 4, 7-11, 20-22, 24 and 25 have been rejected under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 6, 121,302 (“Rothenburger”) in view of U.S. Patent No. 6,682,694 (“Trinh”).

Independent claims 1 and 20 have been amended to include the limitation of claim 23 (i.e., that the antimicrobial composition is free of isothiazolones). Claim 23 has not been rejected over the combination of Rothenburger and Trinh. Notably, Rothenburger requires the presence of isothiazolones for biocidal activity. *See*, e.g., Rothenburger at col. 2, lines 17-23; and col. 2, line 65 – col. 3, line 18. Accordingly, this rejection is moot.

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Claim 23 has been rejected under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 5,405,862 ("Farina") in view of Trinh. Farina is cited by the Examiner as disclosing a composition comprising 27.4% of monomethyldimethylhydantoin, 26.1% of 1,3-dimethylol-5,5-dimethylhydantoin, and 4.2% of dimethylhydantoin. The Examiner acknowledges that Farina fails to teach the addition of dehydroacetic acid, but states that Trinh cures this deficiency. According to the Examiner, it would have been obvious to combine the teachings of Farina and Trinh to arrive at a synergistic antibacterial composition free of isothiazolones.

As discussed above, the limitations of claim 23 have been incorporated into independent claims 1 and 20, and claim 23 has been canceled without prejudice.

The rejection is traversed, and reconsideration is respectfully requested.

Trinh is directed to aqueous odor absorbing solutions comprising cyclodextrin, and an antimicrobial preservative. *See* abstract of Trinh. Trinh lists dozens of possible preservatives. *See* Trinh at col. 7, line 39, to col. 11, line 23. Trinh, however, does not provide any motivation to select dehydroacetic acid from among this long list of antimicrobial preservatives and combine it with the composition in Farina. Furthermore, none of the exemplified formulations in Trinh include dehydroacetic acid.

The Examiner is using impermissible hindsight to reconstruct the invention called for in the present claims by picking and choosing discrete elements from the prior art references. Such hindsight reconstruction has been condemned by the courts. *See In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988) ("One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention"); *In re Fitch*, 23 USPQ2d 1780,

1784 (Fed. Cir. 1992); *See also Symbol Techs., Inc. v. Opticon, Inc.*, 935 F.2d 1569 (Fed. Cir. 1991) (“We do not ‘pick and choose among the individual elements of assorted prior art references to recreate the claimed invention,’ but rather, we look for ‘some teaching or suggestion in the references to support their use in the particular claimed combination.’”). The Examiner provides no reason as to why the skilled artisan would have selected dehydroacetic acid for use in Farina’s composition from the vast number of preservatives disclosed by Trinh.

Furthermore, the synergistic antimicrobial activity of the presently claimed composition was unexpected and would not have been obvious to the skilled artisan. The results of a preservative challenge test are discussed on pages 8 and 9 of the July 3, 2008 response. *See also* page 15, line 13, page 16, line 6, of the specification. These results establish that the combination of Glydant® 2000 (a 70% solution of hydantoin species including about 36% dimethyloldimethylhydantoin, about 29% monomethyloldimethylhydantoin, and about 5% dimethylhydantoin) and dehydroacetic acid (DHA) is synergistic. In other words, the combination is more effective than the additive effect of the individual components.

The Examiner argues that “the combination of Rothenburger and Trinh would motivate making [the claimed composition] and in doing so would result in a composition having synergistic properties.” *See* page 3 of the Office Action. If the Examiner’s rationale were true, no *prima facie* obvious combinations would be patentable. This is clearly not the case. *See, for example, In re Corkill*, 711 F.2d 1496 (Fed. Cir. 1985) (“A greater than expected result is an evidentiary factor pertinent to the legal conclusion of obviousness ... of the claims at issue”); MPEP 716.02(a). The courts and MPEP have stated that evidence of greater than additive (i.e., synergistic) effect is persuasive of nonobviousness where the synergy was not expected. *Id.*; *see also Ex parte The*

NutraSweet Co., 19 USPQ2d 1586, 1589 (Bd. Pat. App. & Inter. 1991). None of the cited references disclose or suggest that a synergistic effect would be achieved by combining the components as presently claimed.

For the foregoing reasons, the presently claimed invention is not obvious over Farina and Trinh, and applicants respectfully request that this rejection be withdrawn.

Conclusion

In view of the above amendments and remarks, it is respectfully requested that the application be reconsidered, and that the pending claim be allowed and the case passed to issue.

If there are any other issues remaining that the Examiner believes can be resolved through either a Supplemental Response or an Examiner's Amendment, the Examiner is respectfully requested to contact the undersigned at the telephone number indicated below.

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Respectfully submitted,

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